

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Raymond G. Schuder et al. Art Unit : 3722
Serial No. : 10/820,649 Examiner : Gates, Eric Andrew
Filed : 4/7/04 Confirmation No.: 8492
Title : SYSTEMS AND METHODS OF ATTACHING A COVER TO A TEXT
BODY

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

I. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. Related Appeals and Interferences

Appellant is not aware of any related appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 9-13, 21-30, and 36-39 are pending. Of these claims, claims 9-13, 21-24, 27-30, and 36-39 stand rejected, and claims 25 and 26 stand allowed.

Claims 1-8, 14-20, and 31-35 have been canceled.

CERTIFICATE OF TRANSMISSION

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Appellant appeals all rejections of the pending rejected claims 9-13, 21-24, 27-30, and 36-39.

IV. Status of Amendments

The amendments filed February 7, 2008, have been entered and acted upon by the Examiner.

No amendments were filed after any of the non-final Office action dated August 12, 2009, the non-final Office action dated December 23, 2008, and the final Office action dated April 14, 2008.

V. Summary of Claimed Subject Matter

A. Independent claim 9

The aspect of the invention defined in independent claim 9 is a bookbinding system that comprises a sheet binder, an adhesive dispenser, and a cover binder (page 7, lines 12-13 and 20-22; page 9, lines 7-10; FIGS. 1 and 7A). The sheet binder is configured to bind with an adhesive two or more sheets (page 7, lines 20-21) into an adhesively bound text body having an exposed spine bounded by two exposed side hinge areas (FIG. 2; page 7, line 30 - page 8, line 3). The adhesive dispenser is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body (page 8, lines 14-32). The cover binder is configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover (page 8, lines 22-24).

B. Dependent claim 13

Claim 13 depends from claim 12 and recites that the adhesive dispenser comprises a take-up spool disposed within the plug-in cartridge housing and configured to reel-in spent carrier ribbon (page 9, lines 13-26; FIGS. 7A and 7B).

C. Independent claim 30

The aspect of the invention defined in independent claim 30 is a bookbinding system that comprises a sheet binder, an adhesive dispenser, and a cover binder (page 7, lines 12-13 and 20-22; page 9, lines 7-10; FIGS. 1 and 7A). The sheet binder configured to bind two or more sheets (page 7, lines 20-21) into a text body having an exposed spine bounded by two exposed side hinge areas (page 7, line 30 - page 8, line 3; FIG. 2). The adhesive dispenser is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body (page 8, lines 14-32). The adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon (page 9, lines 14-17). The adhesive dispenser applies the solid pressure sensitive adhesive film by releasing a film of the pressure sensitive adhesive composition from the carrier ribbon and reeling-in spent carrier ribbon (page 9, lines 18-29). The cover binder is configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover (page 8, lines 22-24).

VI. Grounds of Rejection to be Reviewed on Appeal

A. Claims 9-12, 21-24, 27-29, and 36-39 stand rejected under 35 U.S.C. § 103(a) over Leclerc (U.S. 5,261,769) in view of Ensign (U.S. 6,422,281).

B. Claims 9-12, 21-24, 27-29, and 36-39 stand rejected under 35 U.S.C. § 103(a) over Leclerc (U.S. 5,261,769) in view of Rossini (U.S. 5,261,996).

C. Claims 13 and 30 stand rejected under 35 U.S.C. § 103(a) over Leclerc (U.S. 5,261,769) in view of Ensign (U.S. 6,422,281) and Rossini (U.S. 5,261,996).

VII. Argument

A. Applicable standards for sustaining a rejection under 35 U.S.C. § 103(a)

"A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. §103(a).

In an appeal involving a rejection under 35 U.S.C. § 103, an examiner bears the initial burden of establishing *prima facie* obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). To support a *prima facie* conclusion of obviousness, the prior art must disclose or suggest all the limitations of the claimed invention.¹ See In re Lowry, 32 F.3d 1579, 1582, 32 USPQ2d 1 031, 1034 (Fed. Cir. 1994). If the examiner has established a *prima facie* case of obviousness, the burden of going forward then shifts to the applicant to overcome the *prima facie* case with argument and/or evidence. Obviousness, is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. This inquiry requires (a) determining the scope and contents of the prior art; (b) ascertaining the differences between the prior art and the claims in issue; (c) resolving the level of ordinary skill in the pertinent art; and (d) evaluating evidence of secondary consideration. See KSR Int'l Co. v. Teleflex Inc., No. 127 S. Ct. 1727, 1728 (2007) (citing Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966)). If all claim limitations are found in a number of prior art references, the fact finder must determine whether there was an apparent reason to combine the known elements in the fashion claimed. See KSR, 1741. This analysis should be made explicit. KSR at 1741 (citing In re Kahn, 441 F. 3d 977, 988 (Fed. Cir. 2006): “[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

B. Rejection of claims 9-12, 21-24, 27-29, and 36-39 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign

The Examiner has rejected claims 9-12, 21-24, 27-29, and 36-39 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign.

¹ The U.S. Patent and Trademark Office has set forth the following definition of the requirements for establishing a *prima facie* case of unpatentability (37 CFR § 1.56(b)(ii):

A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

1. Independent claim 9

a. Introduction

Independent claim 9 recites:

Claim 9: A bookbinding system, comprising:
a sheet binder configured to bind with an adhesive two or more sheets into an adhesively bound text body having an exposed spine bounded by two exposed side hinge areas;
an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body; and
a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

The rejection of independent claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign should be withdrawn because Leclerc in view of Ensign does not disclose or suggest all the elements of the claimed invention. The rejection of claim 9 also should be withdrawn because at the time the invention was made there was not any apparent reason to combine the teachings of Leclerc and Ensign in the manner proposed by the Examiner.

b. The Examiner's position and Appellants' rebuttal

i. The Examiner's position

In support of the rejection of claim 9, the Examiner has stated that (see § 3 on pages 3-4 of the Office action; emphasis added):

Regarding claim 9, Leclerc discloses a bookbinding system 10, comprising: a sheet binder 12/34 configured to bind with an adhesive 44 two or more sheets 14 into an adhesively bound text body having an exposed spine 32 bounded by two exposed side hinge areas 66/70; an adhesive dispenser 50/82 configured to apply an adhesive 62/84 between a cover 20 and the side hinge areas of the text body; and a cover binder 16 configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover (the cover binder 16 inherently applies pressure to the cover to attach it to the book block).

Leclerc does not disclose that the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film.

Ensign, Jr., et al. teaches the use of an adhesive dispenser 10 that applies a pressure sensitive adhesive made of one or more layers coated (i.e., a film) on a transfer substrate 170 wound around a core 168 in a plug-in cartridge 26 for the purpose of applying the adhesive layer to a selected substrate 186. Ensign, Jr., et al. also teaches that the system may be redesigned for industrial heavy use applications (see column 15, lines 59-61). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the bookbinding system of Leclerc with the pressure sensitive adhesive application system of Ensign, Jr., et al. in order to be able to replace the hot melt glue guns 50/82 with a pressure sensitive adhesive system that applies a well known adhesive material. Furthermore, it would have been an obvious matter of design choice to load the adhesive dispenser with a transfer substrate having two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine in order to replace the adhesives 62/84 of Leclerc.

ii. Appellants' rebuttal: the cited references do not disclose or suggest the "adhesive dispenser" element of claim 9

The Examiner has acknowledged that Leclerc does not disclose or suggest the "adhesive dispenser" element of claim 1. The Examiner has relied on Rossini to make-up for this lack of disclosure. In particular, the rejection of independent claim 9 is premised on the Examiner's assertion that Ensign discloses an adhesive dispenser that is configured "to replace the hot melt glue guns 50/82" and/or apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine." Contrary to the Examiner's position, however, Ensign does not teach or suggest an adhesive dispenser that is configured "to replace the hot melt glue guns 50/82" nor does Ensign disclose or suggest an adhesive dispenser that is able to apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine."

Instead, Ensign discloses a manually-operated adhesive transfer apparatus that is purposefully designed to apply pressure-sensitive adhesive over an entire surface of a selected substrate. In accordance with Ensign's express teaching, the adhesive transfer system is designed to "effectively transfer adhesive to a selected substrate and substantially eliminate all chances of sticking extra adhesive to undesired surfaces" (col. 2, lines 7-10). To

meet this need, the adhesive transfer apparatus is designed to feed the selected substrate between an adhesive transfer substrate 170 and an adhesive mask substrate 166 such that the adhesive transfer substrate extends over the entire surface of the selected substrate 186 and any portions of the adhesive transfer substrate 170 that extend beyond the edges of the selected substrate 186 are bonded to the adhesive mask substrate 166, which is discarded (see col. 11, lines 4-29 and lines 40-56; FIG. 13). According to Ensign (col. 11, lines 57-67):

The resulting article is the transfer substrate 170 and the selected substrate 186 bonded together by one or more adhesive layers sandwiched therebetween. Substantially all of the adhesive not covered by the selected substrate 186 has been stripped away by the mask substrate 160, which is now wound up on the take-up roll 136. Thus, a user can simply peel back the selected substrate 186 from the transfer substrate 170 and adhere the substrate 186 to any desired contact surface. There is no need to handle or discard the mask substrate 166 because it is wound up on the take-up roll 136.

There is no readily apparent way to configure Ensign's adhesive transfer apparatus such that it could "replace the hot melt glue guns 50/82" or be able to apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine." Moreover, Ensign's adhesive transfer apparatus is expressly designed for the purpose of applying pressure-sensitive adhesive over the entire surface of the selected substrate so that, at some later time, the selected substrate can be peeled off the transfer substrate for adherence to a desired contact surface (see, e.g., col. 1, lines 59-61, and col. 11, lines 52-65). Indeed, the adhesive mask substrate (which is an integral part of Ensign's invention) is provided for the express purpose of eliminating excess adhesive that extends beyond the edges of the selected substrate (see, e.g., col. 2, lines 1-31, and col. 11, lines 62-67).

Thus, Ensign does not disclose or suggest the subject matter relied upon by the Examiner in order to make-up for the acknowledged failure of Leclerc to disclose or suggest the "adhesive dispenser" element of claim 9.

For at least this reason, the rejection of independent claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign should be withdrawn.

It is noted that the Examiner's proposed modification of Leclerc's bookbinding apparatus would not result in the inventive subject matter defined in claim 9 because the side

hinge areas of the cover would not be bound to the text body. In particular, the rejection of claim 9 is premised on the Examiner's assertion that one skilled in the art would have been motivated "to replace the hot melt glue guns 50/82" of Leclerc with Ensign's adhesive transfer apparatus "in order to replace the adhesives 62/84." As shown clearly in FIG. 6 of Leclerc, however, the adhesives 62/84 bind the crash 29 to the side portions 64/68 of the cover 20, but the crash 29 is not bound to the sides 66, 70 of the text block 70; instead, the crash 29 is bound only to the spine portion 32 of the text block 70. Therefore, the Examiner's proposed combination of Leclerc and Ensign would not result in "an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body; and a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover," as recited in claim 9.

For this additional reason, the rejection of independent claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign should be withdrawn.

In the Office action dated August 12, 2009, the Examiner has provided the following reply to Appellant's explanation that Leclerc in view of Ensign does not disclose or suggest the "adhesive dispenser" element of claim 9 (§ 40 on page 16 of the Office action):

Applicant argues that the teachings of Ensign cannot be used to make up for the deficiencies of Leclerc. However, it is noted that Ensign teaches in column 15, lines 59-61 that "the principles of the present invention are not limited by size and the apparatus of a large size for industry heavy use applications", implying that the invention of Ensign is capable of being used for large scale applications beyond the scope of the embodiment in the drawings. Ensign teaches in column 15, line 62 to column 16, line 11, that while a preferred embodiment of the invention teaches a substrate with a similar width as the mask instead of a substrate of greater width, "this feature is preferred and not necessary and should not be considered to limit the invention".

In this reply, however, the Examiner has not addressed the fact that Ensign does not teach or suggest the premise of the Examiner's rejection of claim 9: namely, an adhesive dispenser that is configured "to replace the hot melt glue guns 50/82" and/or an adhesive dispenser that is able to apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine." Instead, the Examiner has pointed to Ensign's generalized statements regarding the

scope of specific features of his invention that do not relate to the replacement of Leclerc's hot melt glue guns 50/82 nor to the application of apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine."

In particular, the Examiner has argued the Ensign's statement in col. 15, lines 56-61, that the principles of his invention are not limited by size means that "the invention of Ensign is capable of being used for large scale applications beyond the scope of the embodiment in the drawings." Similarly, the Examiner also has argued that Ensign's statement in col. 15, line 62 - col. 16, line 11, means that "that while a preferred embodiment of the invention teaches a substrate with a similar width as the mask instead of a substrate of greater width, 'this feature is preferred and not necessary and should not be considered to limit the invention.'"² Neither of these statements, however, constitutes a disclosure of an adhesive dispenser that is configured "to replace the hot melt glue guns 50/82" and/or apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine."

As explained above, Ensign's adhesive transfer apparatus applies pressure-sensitive adhesive over the selected substrate and the adhesive mask substrate eliminates excess adhesive that extends beyond the edges of the selected substrate (see, e.g., col. 2, lines 1-31, and col. 11, lines 62-67) so that, at some later time, the selected substrate can be peeled off the transfer substrate for adherence to a desired contact surface (see, e.g., col. 1, lines 59-61, and col. 11, lines 52-65). There simply is no readily apparent way to configure Ensign's adhesive transfer apparatus such that it could replace Leclerc's hot melt glue guns 50/82 or be able to apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine."

It is noted that the use of a selected substrate that is wider than the mask substrate as proposed by the Examiner would result in there being no bonding between the mask and transfer substrates 344, 346, in which case the mask substrate would slip over the top of the selected substrate without pulling the transfer substrate 346 (see col. 16, lines 1-9 of Ensign) and any excess adhesive that extends beyond the edges of the selected substrate would remain. Such a use scenario does not suggest any apparent way to configure Ensign's

² In col. 16, lines 1-9, Ensign expressly discloses the situation when a substrate of a greater width than the mask is used.

adhesive transfer apparatus such that it could replace Leclerc's hot melt glue guns 50/82 or be able to apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine."

Inexplicably, the Examiner has not even attempted to rebut Appellant's explanation that his proposed modification of Leclerc's bookbinding apparatus would not result in "an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body; and a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover," as recited in claim 9. As explained above, the rejection of claim 9 is premised on the Examiner's assertion that one skilled in the art would have been motivated "to replace the hot melt glue guns 50/82" of Leclerc with Ensign's adhesive transfer apparatus "in order to replace the adhesives 62/84." As shown clearly in FIG. 6 of Leclerc, however, the adhesives 62/84 bind the crash 29 to the side portions 64/68 of the cover 20, but the crash 29 is not bound to the sides 66, 70 of the text block 70; instead, the crash 29 is bound only to the spine portion 32 of the text block 70.

For these additional reasons, the rejection of independent claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign should be withdrawn.

iii. Appellants' rebuttal: one skilled in the art would not have had any apparent reason to combine the cited references in the manner proposed by the Examiner

The rejection of claim 9 over Leclerc in view of Ensign also should be withdrawn because at the time the invention was made there was not any apparent reason to combine the teachings of Leclerc and Ensign in the manner proposed by the Examiner.

In particular, the Examiner has taken the position that one skilled in the art would have been motivated "to replace the hot melt glue guns 50/82" of Leclerc with Ensign's adhesive transfer apparatus "in order to replace the adhesives 62/84" (see page 4 of the Office action). As explained above, however, Ensign's adhesive transfer apparatus is purposefully designed to apply pressure-sensitive adhesive over an entire surface of a selected substrate and there is no readily apparent way to configure Ensign's adhesive transfer apparatus such that it could "replace the hot melt glue guns 50/82" or be able to apply "two laterally spaced

apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine.”

Moreover, even if it were possible to modify Ensign's adhesive transfer apparatus to be able to apply “two laterally spaced apart adhesive films” over selected portions of the cover, such a modification would have obviated the need for the key inventive element of Ensign's invention: namely, the provision of an adhesive mask substrate that automatically removes all excess adhesive that extends beyond the edges of the selected substrate so that “There is no need to handle or discard the mask substrate 166 because it is wound up on the take-up roll 136” (col. 11, lines 65-67; also see col. 2, lines 1-31). A modification that obviates the underlying need or purpose of an invention hardly would be an obvious modification. For this reason, Ensign effectively teaches away from the Examiner's proposed modification of Leclerc's bookbinding system.

In addition, the motivation given by the Examiner in support of the combination of Leclerc and Ensign (i.e., “in order to be able to replace the hot melt glue guns 50/82 with a pressure sensitive adhesive system that applies a well known adhesive material”) is not supported by any of the Leclerc, Ensign, or the knowledge generally available at the time the invention was made. Indeed, neither Leclerc nor Ensign discloses anything that would have led one skilled in the art to believe that the pressure sensitive adhesive that is transferred from the transfer substrate 170 to the selected substrate 186 by Ensign's adhesive transfer apparatus is an art recognized equivalent of the hot melt glue that is applied by Leclerc's hot melt glue guns 50/82. For these reasons, the rationale given by the Examiner in support of the rejection of independent claim 9 amounts to no more than a conclusory statement that does not have any rational underpinning that supports a rejection under 35 U.S.C. § 103. See *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 14 (U.S. Apr. 30, 2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006): “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

For these additional reasons, the rejection of independent claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign should be withdrawn.

iv. Conclusion

For at least the reasons explained above, the rejection of claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign should be withdrawn.

2. Dependent claims 10-12, 21-24, 27-29, and 36-39

Each of claims 10-12, 21-24, 27-29, and 36-39 incorporates the elements of independent claim 9 and therefore is patentable over Leclerc in view of Ensign for at least the same reasons explained above.

C. Rejections of claims 9-12, 21-24, 27-29, and 36-39 over Leclerc in view of Rossini

The Examiner has rejected claims 9-12, 21-24, 27-29, and 36-39 under 35 U.S.C. § 103(a) over Leclerc (U.S. 5,261,769) in view of Rossini (U.S. 5,261,996).

1. Independent claim 9

a. Introduction

Independent claim 9 recites:

Claim 9: A bookbinding system, comprising:
a sheet binder configured to bind with an adhesive two or more sheets into an adhesively bound text body having an exposed spine bounded by two exposed side hinge areas;
an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body; and
a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

The rejection of independent claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Rossini should be withdrawn because Leclerc in view of Rossini does not disclose or suggest all the elements of the claimed invention. The rejection of claim 9 also should be withdrawn because at the time the invention was made there was not any apparent reason to combine the teachings of Leclerc and Rossini in the manner proposed by the Examiner.

b. The Examiner's position and Appellants' rebuttal

i. The Examiner's position

In support of the rejection of claim 9, the Examiner has stated that (see § 19 on pages 8-9 of the Office action; emphasis added):

Regarding claim 9, Leclerc discloses a bookbinding system 10, comprising: a sheet binder 12/34 configured to bind with an adhesive 44 two or more sheets 14 into an adhesively bound text body having an exposed spine 32 bounded by two exposed side hinge areas 66/70; an adhesive dispenser 50/82 configured to apply an adhesive 62/84 between a cover 20 and the side hinge areas of the text body; and a cover binder 16 configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover (the cover binder 16 inherently applies pressure to the cover to attach it to the book block).

Leclerc does not disclose that the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film. Rossini teaches the use of an adhesive dispenser 10 that applies a pressure sensitive adhesive 34 made of one or more layers coated on a transfer substrate 48 wound around a core in a plug-in cartridge housing 42 (spool 42 is a plug-in cartridge housing in as much as the outer portion seen in figure 1 forms a cartridge housing containing a supply spool (inner portion on which roll of adhesive sits) that is plugged into the adhesive dispenser 10) for the purpose of applying discrete lengths of adhesive 12 to a selected substrate 14. Rossini also teaches that the system uses a take-up reel 46 for the transfer substrate 48. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the bookbinding system of Leclerc with the pressure sensitive adhesive application system of Rossini in order to be able to replace the hot melt glue guns 50/82 with a pressure sensitive adhesive system that applies a well known alternative adhesive material. Furthermore, it would have been an obvious matter of design choice to load the adhesive dispenser with a transfer substrate having two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine in order to replace the adhesives 62/84 of Leclerc.

ii. Appellants' rebuttal: the cited references do not disclose or suggest the "adhesive dispenser" element of claim 9

The Examiner has acknowledged that Leclerc does not disclose or suggest the "adhesive dispenser" element of claim 1. The Examiner has relied on Rossini to make-up for this lack of disclosure. In particular, the Examiner has relied on Rossini to make-up for the failure of Leclerc to disclose or suggest an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body.

Rossini discloses a guiding system that guides a strip of web material ("tapes, films, foils or the like") to a vacuum wheel and aligns the web material on the vacuum wheel for accurate cutting of the web material into discrete lengths that are applied to a continuously moving sequence of articles (see, e.g., col. 1, lines 6-24).

In support of the rejection of claim 9, the Examiner has taken the position that the configuration of Rossini's applicator machine 10 described in col. 8, lines 12-34 in which the applicator machine 10 applies an "adhesive tape" to a substrate constitutes "an adhesive dispenser configured to apply a solid pressure sensitive adhesive film" that is suitable for application between a cover and the side hinge areas of a text body and subsequent use in binding the cover to the side hinge areas of the text body by applying pressure to the cover. Contrary to the Examiner's assumption, however, the adhesive tape disclosed in Rossini does not constitute such a solid pressure sensitive adhesive film. In accordance with Rossini's disclosure, the adhesive tape is a web material that has a single adhesive side with a pressure sensitive adhesive or other adhesive and an overlying protective release layer 48 (see col. 8, lines 19-34). When used with such a tape, the applicator machine 10 removes protective release layer 48 and applies the exposed adhesive side of the tape to a substrate with the non-adhesive side of the tape facing away from the substrate. Applied in this way, the adhesive tape does not constitute "a solid pressure sensitive adhesive film" that is suitable for application between a cover and the side hinge areas of a text body and subsequent use in binding the cover to the side hinge areas of the text body by applying pressure to the cover.

For at least this reason, the rejection of independent claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Rossini should be withdrawn.

It is noted that the Examiner's proposed modification of Leclerc's bookbinding apparatus would not result in the inventive subject matter defined in claim 9. In particular, the Examiner's proposed combination of Leclerc and Ensign would not result in "an adhesive

dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body; and a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover,” as recited in claim 9. Instead, the Examiner’s proposed modification of Leclerc’s bookbinding apparatus would result in a bookbinding apparatus in which the glue guns 50, 82 were replaced with tape dispensers that applied single-sided tape to cover 20 with the adhesive side of the tape attached to the cover and the non-adhesive side of the tape facing away from the cover. As a result, the cover applying station 16 would not be able to “bind the cover to the side hinge areas of the text body by applying pressure to the cover” because the non-adhesive side of the tape would not adhere to the book blocks.

In addition, the Examiner’s proposed modification of Leclerc’s bookbinding apparatus would not result in the inventive subject matter defined in claim 9 because the side hinge areas of the cover would not be bound to the text body. In particular, the rejection of claim 9 is premised on the Examiner’s assertion that one skilled in the art would have been motivated “to replace the hot melt glue guns 50/82” of Leclerc with Ensign’s adhesive transfer apparatus “in order to replace the adhesives 62/84.” As shown clearly in FIG. 6 of Leclerc, however, the adhesives 62/84 bind the crash 29 to the side portions 64/68 of the cover 20, but the crash 29 is not bound to the sides 66, 70 of the text block 70; instead, the crash 29 is bound only to the spine portion 32 of the text block 70. Therefore, the Examiner’s proposed combination of Leclerc and Ensign would not result in “an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body; and a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover,” as recited in claim 9.

For these additional reasons, the rejection of independent claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Rossini should be withdrawn.

iii. Appellants’ rebuttal: one skilled in the art would not have had any apparent reason to combine the cited references in the manner proposed by the Examiner

The rejection of claim 9 over Leclerc in view of Ensign also should be withdrawn because at the time the invention was made there was not any apparent reason to combine the teachings of Leclerc and Rossini in the manner proposed by the Examiner.

As explained above, the Examiner's proposed modification of Leclerc's bookbinding apparatus would result in a bookbinding apparatus in which the glue guns 50, 82 were replaced with tape dispensers that applied single-sided tape to cover 20 with the adhesive side of the tape attached to the cover and the non-adhesive side of the tape facing away from the cover. As a result, the cover applying station 16 would not be able to "bind the cover to the side hinge areas of the text body by applying pressure to the cover" because the non-adhesive side of the tape would not adhere to the book blocks. For this reason, one skilled in the art would not have had any apparent reason to modify Leclerc's bookbinding apparatus as proposed by the Examiner because such a modification would render the bookbinding apparatus inoperable for its intended purpose: namely, binding the cover 20 to the book block 14.

In addition, the motivation given by the Examiner in support of the combination of Leclerc and Ensign (i.e., "in order to be able to replace the hot melt glue guns 50/82 with a pressure sensitive adhesive system that applies a well known alternative adhesive material") is not supported by any of the Leclerc, Ensign, or the knowledge generally available at the time the invention was made. Indeed, neither Leclerc nor Ensign discloses anything that would have led one skilled in the art to believe that the single-sided tape that is applied by Rossini's applicator machine 10 is an art recognized alternative to the hot melt glue that is applied by Leclerc's hot melt glue guns 50/82. To the contrary, Rossini's single-sided tape is incapable of binding the cover 20 to the book block 14 and therefore clearly is not an art recognized alternative to the hot melt glue that is applied by Leclerc's hot melt glue guns 50/82.

For these additional reasons, the rejection of independent claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Rossini should be withdrawn.

iv. Conclusion

For at least the reasons explained above, the rejection of claim 9 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign should be withdrawn.

2. Dependent claims 10-12, 21-24, 27-29, and 36-39

Each of claims 10-12, 21-24, 27-29, and 36-39 incorporates the elements of independent claim 9 and therefore is patentable over Leclerc in view of Ensign for at least the same reasons explained above.

D. Rejections of claims 13 and 30 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign and Rossini

The Examiner has rejected claims 13 and 30 under 35 U.S.C. § 103(a) over Leclerc (U.S. 5,261,769) in view of Ensign (U.S. 6,422,281) and Rossini (U.S. 5,261,996).

1. Dependent claim 13

Claim 13 incorporates the elements of independent claim 9. Rossini does not make-up for the failure of Leclerc in view of Ensign to disclose or suggest the elements of independent claim 9 discussed above. Therefore, claim 13 is patentable over Leclerc in view of Ensign and Rossini for at least the same reasons explained above in connection with independent claim 9.

The rejection of claim 13 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign and Rossini also should be withdrawn for the following additional reason.

Claim 13 depends from claim 12 and recites that the adhesive dispenser comprises a take-up spool disposed within the plug-in cartridge housing and configured to reel-in spent carrier ribbon.

The Examiner has acknowledged that Leclerc in view of Ensign does not disclose an adhesive dispenser that includes a take-up spool configured to reel-in spent carrier ribbon on which a solid pressure sensitive adhesive film was disposed, as recited in claim 13 (see § 20 on page 7 of the Office action). Indeed, in accordance with Leclerc's express teaching, the portion of the transfer substrate 170 that is applied to the selected substrate 186 remains on the selected substrate until it is manually peeled off for adherence of the selected substrate to a desired contact surface (see, e.g., col. 1, lines 59-61, and col. 11, lines 57-67).

The Examiner has cited Rossini in an effort to make-up for this failure of the teachings of the Leclerc in view of Ensign. In particular, the Examiner has stated that "Rossini teaches the use of an applicator system that applies an adhesive material 34 in the form of a tape that is adhered to a carrier ribbon 48, further comprising a take-up reel 46 for

the purpose of reeling in the spent carrier ribbon.” Contrary to the Examiner’s statement, however, Rossini does not teach that the take-up spool reels in the web material 34, which serves as the carrier ribbon on which the adhesive is disposed. Instead, Rossini teaches that the take-up reel 46 is used to wind the waste strip of a protective release layer 48 (which is separate and distinct from the adhesive carrying web material 34) that may be disposed on the adhesive side of the tape (see col. 8, lines 19-34).

For at least this additional reason, the rejection of claim 13 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign and Rossini should be withdrawn.

2. Independent claim 30

Independent claim 30 recites:

Claim 30: A bookbinding system, comprising:

a sheet binder configured to bind two or more sheets into a text body having an exposed spine bounded by two exposed side hinge areas;

an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body, wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon, and the adhesive dispenser applies the solid pressure sensitive adhesive film by releasing a film of the pressure sensitive adhesive composition from the carrier ribbon and reeling-in spent carrier ribbon; and

a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

The rejection of independent claim 30 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign and Rossini should be withdrawn because Leclerc in view of Ensign and Rossini, does not disclose or suggest all the elements of the claimed invention. The rejection of claim 30 also should be withdrawn because at the time the invention was made there was not any apparent reason to combine the teachings of Leclerc, Ensign, and Rossini in the manner proposed by the Examiner.

The Examiner has acknowledged that Leclerc in view of Ensign does not disclose an adhesive dispenser that includes a take-up spool configured to reel-in spent carrier ribbon on

which a solid pressure sensitive adhesive film was disposed, as recited in claim 30 (see § 21 on page 8 of the Office action).

The Examiner has cited Rossini in an effort to make-up for this failure of the teachings of Leclerc in view of Ensign. In particular, the Examiner has stated that "Rossini teaches the use of an applicator system that applies an adhesive material 34 in the form of a tape that is adhered to a carrier ribbon 48, further comprising a take-up reel 46 for the purpose of reeling in the spent carrier ribbon." Contrary to the Examiner's statement, however, Rossini does not teach that the take-up spool reels in the web material 34, which serves as the carrier ribbon on which the adhesive is disposed. Instead, Rossini teaches that the take-up reel 46 is used to wind the waste strip of a protective release layer 48 (which is separate and distinct from the adhesive carrying web material 34) that may be disposed on the adhesive side of the tape (see col. 8, lines 19-34).

Furthermore, none of the cited references discloses or suggests an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body. For the reasons explained above in connection with independent claim 9, Leclerc in view of Ensign does not disclose or suggest an adhesive dispenser that is configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body. In addition, Rossini does not disclose or suggest anything that would have given one skilled in the art any apparent reason to apply his single-sided adhesive tape 34 between a cover and the side hinge areas of an adhesively bound text body using his system for guiding a web material to and along a vacuum wheel applicator (see, e.g., col. 1, lines 6-17). Thus, none of the cited references discloses or suggest "the adhesive dispenser applies the solid pressure sensitive adhesive film by releasing a film of the pressure sensitive adhesive composition from the carrier ribbon and reeling-in spent carrier ribbon," as recited in claim 39. Consequently, there is no combination of the cited references that possibly could disclose or suggest such a feature. For at least this reason, the Examiner's rejection of claim 30 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign and Rossini should be withdrawn.

The rejection of claim 30 over Leclerc in view of Ensign and Rossini also should be withdrawn because at the time the invention was made there was not any apparent reason to combine the teachings of Leclerc in view of Ensign and Rossini in the manner proposed by the Examiner.

For the reasons explained above in connection with claim 9, one skilled in the art would not have been motivated to combine the teachings of Leclerc and Ensign in the manner proposed by the Examiner. In particular, the Examiner has taken the position that one skilled in the art would have been motivated "to replace the hot melt glue guns 50/82" of Leclerc with Ensign's adhesive transfer apparatus "in order to replace the adhesives 62/84." As explained above, however, Ensign's adhesive transfer apparatus is purposefully designed to apply pressure-sensitive adhesive over an entire surface of a selected substrate and there is no readily apparent way to configure Ensign's adhesive transfer apparatus such that it could "replace the hot melt glue guns 50/82" or be able to apply "two laterally spaced apart adhesive films for the purpose of being able to use the bookbinding system to apply adhesive on both sides of the book block spine."

Moreover, even if it were possible to modify Ensign's adhesive transfer apparatus to be able to apply "two laterally spaced apart adhesive films" over selected portions of the cover, such a modification would have obviated the need for the key inventive element of Ensign's invention: the provision of an adhesive mask substrate that automatically removes all excess adhesive that extends beyond the edges of the selected substrate so that "There is no need to handle or discard the mask substrate 166 because it is wound up on the take-up roll 136" (col. 11, lines 65-67; also see col. 2, lines 1-31). A modification that obviates the underlying need or purpose of an invention hardly would be an obvious modification. For this reason, Ensign effectively teaches away from the Examiner's proposed modification of Leclerc's bookbinding system.

In addition, the motivation given by the Examiner in support of the combination of Leclerc and Ensign (i.e., "in order to be able to replace the hot melt glue guns 50/82 with a pressure sensitive adhesive system that is easy to maintain") is not supported by any of the Leclerc, Ensign, or the knowledge generally available at the time the invention was made. Indeed, neither Leclerc nor Ensign discloses anything about the relative ease of maintenance between hot melt adhesive and pressure-sensitive adhesive systems. In addition, common sense suggests that the substitution of Ensign's adhesive transfer system (with the concomitant need to manage the adhesive transfer substrate, the adhesive mask substrate and the associated removable cartridge) would be at least as difficult to maintain as and certainly much more expensive than the hot-melt glue based adhesive system actually used by Leclerc, without providing any readily apparent performance benefit. For these reasons, the rationale

given by the Examiner in support of the rejection of independent claim 9 amounts to no more than a conclusory statement that does not have any rational underpinning that supports a rejection under 35 U.S.C. § 103. See *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, slip op. at 14 (U.S. Apr. 30, 2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006): “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

For these additional reasons, the rejection of independent claim 30 under 35 U.S.C. § 103(a) over Leclerc in view of Ensign and Rossini should be withdrawn.

VIII. Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

Charge any excess fees or apply any credits to Deposit Account No. 08-2025.

Respectfully submitted,

Date: January 5, 2010

/Edouard Garcia, Reg. No. 38,461/
Edouard Garcia
Reg. No. 38,461
Telephone No.: (650) 605-3532

Please direct all correspondence to:
Hewlett-Packard Company
Intellectual Property Administration
Legal Department, M/S 35, P.O. Box 272400
Fort Collins, CO 80528-9599

CLAIMS APPENDIX

The claims that are the subject of Appeal are presented below.

Claims 1-8 (canceled)

Claim 9 (previously presented): A bookbinding system, comprising:
a sheet binder configured to bind with an adhesive two or more sheets into an adhesively bound text body having an exposed spine bounded by two exposed side hinge areas;
an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body; and
a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

Claim 10 (original): The bookbinding system of claim 9, wherein the adhesive dispenser is configured to apply a solid pressure sensitive adhesive film to the cover in a series of spaced-apart strips.

Claim 11 (previously presented): The bookbinding system of claim 9, wherein the adhesive dispenser comprises a plug-in cartridge housing.

Claim 12 (original): The bookbinding system of claim 11, wherein the adhesive dispenser comprises a supply spool disposed within the plug-in cartridge housing and configured to support a roll of pressure sensitive adhesive tape formed from a solid pressure sensitive adhesive film disposed on a carrier ribbon.

Claim 13 (original): The bookbinding system of claim 12, wherein the adhesive dispenser comprises a take-up spool disposed within the plug-in cartridge housing and configured to reel-in spent carrier ribbon.

Claims 14-20 (canceled)

Claim 21 (previously presented): The bookbinding system of claim 9,

wherein the adhesive dispenser applies the solid pressure sensitive adhesive film to the cover before the cover binder contacts the applied solid pressure sensitive adhesive to the side hinge areas of the text body.

Claim 22 (previously presented): The bookbinding system of claim 9, wherein the cover binder binds the cover to the spine of the text body by positioning a portion of the cover over the spine of the text body and applying pressure to the portion of the cover positioned over the spine of the text body.

Claim 23 (previously presented): The bookbinding system of claim 22, wherein the adhesive dispenser applies the solid pressure sensitive adhesive film as a single continuous strip with a width dimension that is wider than the exposed spine of the text body.

Claim 24 (previously presented): The bookbinding system of claim 22, wherein the adhesive dispenser applies the solid pressure sensitive adhesive film in a series of multiple strips over an area corresponding to the side hinge areas and the exposed spine of the text body.

Claim 25 (previously presented): A bookbinding system, comprising:
a sheet binder configured to bind two or more sheets into a text body having an exposed spine bounded by two exposed side hinge areas;
an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body, wherein the adhesive dispenser applies between the cover and the side hinge areas a solid pressure sensitive adhesive film that comprises a pressure sensitive adhesive composition laminated to a hot melt adhesive film; and
a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

Claim 26 (previously presented): The bookbinding system of claim 25, wherein:

the adhesive dispenser applies the solid pressure sensitive adhesive film with the hot melt adhesive film in contact with the side hinge areas and the exposed spine of the text body;

the sheet binder melts the hot melt adhesive film to bind the two or more sheets into the text body; and

the cover binder binds the cover to the side hinge areas of the text body by disposing the cover over the text body and applying pressure to the cover to activate the pressure sensitive adhesive composition.

Claim 27 (previously presented): The bookbinding system of claim 9, wherein the cover binder contacts the side hinge areas to the applied solid pressure sensitive adhesive film.

Claim 28 (previously presented): The bookbinding system of claim 9, wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive.

Claim 29 (previously presented): The bookbinding system of claim 28, wherein the adhesive dispenser dispenses from the roll a solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon.

Claim 30 (previously presented): A bookbinding system, comprising:

a sheet binder configured to bind two or more sheets into a text body having an exposed spine bounded by two exposed side hinge areas;

an adhesive dispenser configured to apply a solid pressure sensitive adhesive film between a cover and the side hinge areas of the text body, wherein the adhesive dispenser dispenses the solid pressure sensitive adhesive from a roll of solid sheet adhesive that comprises a pressure sensitive adhesive composition dispersed on a carrier ribbon, and the adhesive dispenser applies the solid pressure sensitive adhesive film by releasing a film of the pressure sensitive adhesive composition from the carrier ribbon and reeling-in spent carrier ribbon; and

a cover binder configured to bind the cover to the side hinge areas of the text body by applying pressure to the cover.

Claims 31-35 (canceled)

Claim 36 (previously presented): The bookbinding system of claim 9, further comprising a roll of the solid sheet adhesive loaded in the adhesive dispenser.

Claim 37 (previously presented): The bookbinding system of claim 9, wherein the cover binder positions the cover over the exposed side hinge areas and the exposed spine of the text body and applies pressure to the positioned cover to activate the pressure sensitive adhesive film.

Claim 38 (previously presented): The bookbinding system of claim 37, wherein the cover binder applies pressure to the positioned cover to activate the pressure sensitive adhesive film without applying heat.

Claim 39 (previously presented): The bookbinding system of claim 10, wherein the adhesive dispenser applies the spaced-apart strips of the solid pressure sensitive adhesive film respectively over areas of the cover corresponding to the spine and the side hinge areas of the text body.

EVIDENCE APPENDIX

There is no evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132 or any other evidence entered by the Examiner and relied upon by Appellant in the pending appeal. Therefore, no copies are required under 37 CFR § 41.37(c)(1)(ix) in the pending appeal.

Applicant : Raymond G. Schuder et al.
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Attorney's Docket No. : 10002621-2
Appeal Brief dated Jan. 8, 2010
Reply to Office action dated Aug. 12, 2009

RELATED PROCEEDINGS APPENDIX

Appellant is not aware of any decisions rendered by a court or the Board that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Therefore, no copies are required under 37 CFR § 41.37(c)(1)(x) in the pending appeal.